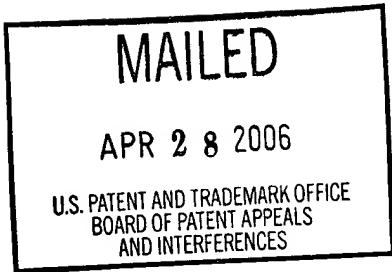


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MITCHELL R. BAUER



Appeal No. 2005-2420
Application No. 09/556,647

ON BRIEF

Before MCQUADE, CRAWFORD, and BAHR, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 15 to 18, 21, 22 and 31 to 39. Claims 1 to 14 have been withdrawn from consideration. Claims 19 and 20 are objected to.

The appellant's invention relates to a method and apparatus for a user to select products using filters based on customer application criteria (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Purcell	5,940,807	Aug. 17, 1999
Peterson et al. (Peterson)	6,324,522 B2	Nov. 27, 2001
Salvo et al. (Salvo)	6,341,271 B1	Jan. 22, 2002

The rejections

Claims 22 and 31 to 39 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.¹

Claims 22 and 31 to 33 and 39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Salvo.

Claims 15 to 18, 21, 22, 31 to 33 and 39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Purcell.

Claims 15 to 18, 21, 22, 31 to 33 and 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Salvo.

¹ The examiner's rejection of claims 16 and 18 under 35 U.S.C. § 112, second paragraph which was discussed in the final rejection is not included in the rejections listed or discussed in the answer. Therefore, we will not discuss this rejection.

Claims 15 to 18 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Salvo and appellant's admissions regarding the "substantially verbatim" standard.

Claims 15 to 18, 21, 22, 31 to 33 and 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Purcell in view of Peterson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed July 19, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed December 22, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's 35 U.S.C. § 112, second paragraph of claims 22, and 31 to 39. We initially note that the second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed

in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

With this as background, we analyze the specific rejections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal.

The examiner is of the opinion that the claims are indefinite under two grounds. Firstly, the examiner states that it is unclear if the appellant intends to claim in claim 22:

... the combination (e.g. the computer system *in addition to* the information itself; or the computer system *in addition to* the computer program; or the computer system *in addition to* the network including the local area network, the Internet, the server, host, and/or ISP, etc. as shown in Figure 1), ... the Examiner has interpreted the claim as a combination claim including all physical structures shown in Figure 1. ...

The Examiner has considered all arguments of record and finds that the computer program is not part of the claim [answer at pages 5 to 6.]

We do not agree with the examiner. Rather, in our view, it is clear when claim 22 is read in light of the specification, that the claim is a combination of the computer system including the software which programs the computer system. In this regard, the specification discloses that processor 104 with memory 106, which has been programed by a computer program, stores a list of products of raw materials with each of the products or materials having various customer application criteria (specification page 6) and that this processor so programmed provides a plurality of filter lists (see Fig. 3). The means for displaying the browser is the display 112 which is connected to the programmed processor 104. The programmed processor 104, along with a selection device available to the user, are the means for selecting one of the filter lists and for specifying a filter criterion (see Fig. 3). The processor filters the list and displays on the display 112 the filtered list and products or materials matching the filter criterion.

As such, it is clear that claim 22 is a combination claim which includes the above mentioned means. In this regard, the computer program is part of the claim because it is the processor, programed by the computer program, which provides the various means recited. Therefore, we are not in agreement with the examiner that it is unclear what is covered by the recitations in claim 22.

The examiner also asserts that the specification does not clearly link the corresponding structure to the various means recited in claim 22. We do not agree, as we have stated above, it is clear what structure is a part of the various means recited in claim 22.

In view of the foregoing, the examiner's rejection of claim 22 and claims 31 to 39, dependent thereon, is not sustained.

We turn next to the examiner' rejection of claims 22, 31 to 33 and 39 under 35 U.S.C. § 102 as being anticipated by Salvo. We initially note that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference.

In support of this rejection, the examiner finds:

Salvo discloses means for storing (the hard drive or memory associated with control unit 114); means for populating a plurality of filter lists (the computer the customer's use to input their desired product such as site controller 112); means for displaying a material browser (a computer monitor inherent in any computer); means for selecting one of the computer lists (again an ordinary personal computer having a mouse); means for filtering (the CPU associated with control unit 114); the display means is configured for

displaying; mean for sorting a filtered list (again inherent within virtually any personal computer including controller 114) [final rejection at pages 5 to 6].

In essence, it is the position of the examiner that as the computer described in Salvo can be programmed to perform the claimed functions, the claimed functions are old and well known (answer at page 11). As such, the examiner does not find that Salvo describes a means for sorting a list of products, means for populating a plurality of filter lists, means for displaying a browser including the filter lists, means for selecting the one product from the filter list etc. as required by claim 22.

We will not sustain this rejection. It is well established that a general purpose computer becomes a new machine when programmed to perform specific functions.

In re Alappat, 33 F.3d 1526, 1545, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994). The computer of claims 22, 31 to 33 and 39 is a special purpose computer with means to perform the various functions recited. As the examiner has not established that Salvo describes the special purpose computer recited in claims 22, 31 to 33 and 39, the examiner has failed to establish a prima facie case of anticipation.

We turn next to the examiner's rejection of claims 15 to 18, 21, 22, 31 to 33 and 39 under 35 U.S.C. § 102 as being anticipated by Purcell. The examiner's finding regarding the teachings of Purcell with regard to the claim limitations is contained on pages 6 and 7 of final rejection.

The appellant argues that Purcell does not describe "storing in a computer system a list of different raw materials, with each of the raw materials having various customer application criteria stored therewith, and said criteria being indicative of intended application of the raw material in a product" as required by claim 15.

We find that Purcell does indeed describe a computer system for storing a list of different raw materials. Purcell describes that one of the products which may be purchased by a buyer are oil field products such as casing pipe, which may be used in oil industry products and as such describes the sale of raw materials as broadly claimed. Purcell also describes that the various sizes, thicknesses and the thread specification is listed (col. 9, lines 36 to 50). As Purcell allows a buyer to select the size, thickness and thread specification, Purcell describes that customer application criteria is stored with the list of raw materials. This is so because a specific size, thickness and thread specification corresponds to the use to be made of the specific pipe and thus relates to the intended purpose of the pipe.

Appellant also argues that Purcell does not describe populating filter lists corresponding with stored customer application criteria as required by claim 15 or means for populating a filter list corresponding with stored customer application criteria as required by claim 22.

We do not agree. Purcell describes that the buyer can filter the buyers list so that only certain selected products (for example, size, thickness or thread count) are

listed for review (col. 4, lines 20 to 24). The size, thickness and thread count corresponds to customer application criteria.

Appellant also argues that the Purcell system does not allow the sellers to filter the lists for some purpose. This argument is not persuasive because it is not commensurate in scope with the language of the claims which do not recite that the sellers filter the lists for some purpose.

In regard to claim 16 and claim 31, the appellant argues that Purcell does not disclose displaying in the browser various customer application criteria. We do not find this argument persuasive because Purcell describes that products meeting the buyer's specified criteria are displayed. For instance, the size, thickness and thread count of the pipe, which in our view are customer application criteria, are displayed in Purcell (col. 5, lines 13 to 19). Therefore, we will sustain this rejection as it is directed to claim 16 and 32.

In regard to claim 17 and claim 32, appellant argues that Purcell does not describe filtering the filter lists of claim 15 to obtain a corresponding selected filter list. We do not agree. Purcell does describe that the list may be further condensed or filtered so that products which meet certain buyer criteria may be listed (col. 5, lines 19 to 25).

Appellant argues that Purcell does not describe storing information different than said customer application criteria as required by claims 18 and 33.

We do not agree. Purcell discloses that the buyers typically view the administrator of the system as the sole provider of the listed products and that information about the seller, which is not customer application criteria, stored in a clearing house (col. 7, lines 24 to 31). In addition, the system stores a unique identifier for each buyer and seller and each product sold (col 4, line 33; 57 to 59). These unique identifiers are not buyer application criteria.

In view of the foregoing, we will sustain the examiner's rejection of claims 15 to 18 and 22, 31 to 33.

In regard to claims 21 and 39, we note that the examiner has not directed our attention to a disclosure in the Purcell reference related to sorting the filtered list according to unit cost of the raw material. Therefore, we will not sustain this rejection as it is directed to claims 21 and 39.

We turn next to the rejections of claims 15 to 18, 21, 22, 31 to 33 and 39 under 35 U.S.C. § 103 as being unpatentable over Salvo. We note that in rejecting claims under 35 U.S.C. §103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ

560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The examiner states:

... Salvo disclose the claimed invention, should the Board find technical violation by the Examiner thus negating a 102 rejection, the Examiner has provided alternative 103 rejections to support and small differences. The Examiner encourages the Board to use the cited three How reference"" to fill in any gaps they encounter [answer at page 12].

We must remind the examiner that it is his duty to establish a prima facie case of obviousness not the members of this panel of the board. Notwithstanding the examiner's encouragement, we will not sift through the prior art to establish the prima facie case of obviousness that the examiner has failed to establish. As the examiner

has failed to establish a prima facie case of obviousness with regard to Salvo, we will not sustain this rejection.

We turn next to the examiner's rejection of claims 15 to 18 and 21 under 35 U.S.C. § 103 as being unpatentable over Salvo and appellant's admissions regarding the "substantially verbatim" standard.

In regard to this rejection, the examiner states:

Having established that Group IV is not patentable over the prior art, the Examiner notes that claims 15-18 and 21 are rejected as being obvious in view of Applicant's implied admission that the inventions are not patentably distinct [answer at page 12].

The examiner appears to be arguing that since appellant has argued, in response to a restriction requirement that claims 22 and 31 to 39 are not patentably distinct from claims 15 to 18 and 21, these latter referenced claims are not patentable for the same reasons found for claims 22 and 31 to 39.

We do not recognize the examiner's rationale as a statutory ground for unpatentability and thus we will not sustain this rejection.

We turn lastly to the examiner's rejection of claims 15 to 18, 21, 22, 31 to 33 and 39 under 35 U.S.C. § 103 as being unpatentable over Purcell in view of Peterson. The examiner relies on Peterson for teaching criteria indicative of intended application of the raw material.

As we have found Purcell sufficient to disclose a criteria indicative of intended application of raw material, we will sustain this rejection of claims 15 to 18, 22 and 31 to 33 for the same reasons given above for the 102 rejection of the claims as being anticipated by Purcell.

As we stated above, we find no teaching in Purcell for the subject matter of claims 21 and 39. We have examined Peterson and find that Peterson does not cure the deficiencies of the Purcell reference. Therefore, we will not sustain this rejection as it is directed to claims 21 and 39.

In conclusion:

The examiner's rejection of claims 22 and 31 to 39 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention is not sustained.

The examiner's rejection of claims 22 and 31 to 33 and 39 under 35 U.S.C. § 102(e) as being anticipated by Salvo is not sustained.

The examiner's rejection of claims 15 to 18, 22, and 31 to 33 under 35 U.S.C. § 102(e) as being anticipated by Purcell is sustained. The examiner's rejection of claims 21 and 39 under 35 U.S.C. § 102(e) as being anticipated by Purcell is not sustained.

The examiner's rejection of claims 15 to 18, 21, 22, 31 to 33 and 39 under 35 U.S.C. § 103 as being unpatentable over Salvo is not sustained.

The examiner's rejection of claims 15 to 18 and 21 under 35 U.S.C. § 103 as being unpatentable over Salvo and appellant's admissions regarding the "substantially verbatim" standard is not sustained.

The examiner's rejection of claims 15 to 18, 22, and 31 to 33 under 35 U.S.C. § 103 as being unpatentable over Purcell in view of Peterson is sustained. The examiner's rejection of claims 21 and 39 under 35 U.S.C. § 103 as being unpatentable over Purcell in view of Peterson is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


JOHN B. MCQUADE

JOHN P. McQUADE
Administrative Patent Judge


MURRIEL E. CRAWFORD
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

Appeal No. 2005-2420
Application No. 09/556,647

Page 16

DOUGLAS S. FOOTE
NCR CORPORATION 1700 S. PATTERSON BLVD. WHQ5E
WHO-5E
DAYTON, OH 45479

MEC/jrg